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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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RECORDED  
SEARCHED  
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APR 15 1996  
U.S. PATENT AND TRADEMARK OFFICE  
COMMISSIONER OF PATENTS AND TRADEMARKS

EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

APR 15 1996

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

*See the attached.*

<b>Office Action Summary</b>	Application No. <b>08/476,798</b>	Applicant(s) <b>Deboer et al.</b>
	Examiner <b>Karen M. Hauda</b>	Group Art Unit <b>1819</b>

Responsive to communication(s) filed on Jun 11, 1997

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 98 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 98 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

Applicant's amendment was filed June 11, 1997. Claim 98 is pending.

### *Claim Rejections - 35 USC § 102*

The prior rejection of claim 98 under 35 U.S.C. § 112, first paragraph is maintained.

Applicants argue that the DNA sequence claimed by applicant is not the same as that disclosed by Conneely et al. because it differs at amino acid #'s 130, 151 and 403. Applicant's arguments have been carefully considered, but are not deemed persuasive.

Claim 3 of the Conneely patent encompasses naturally occurring alleles of Conneely's SEQ ID # 1. Applicant's SEQ ID #1 was isolated by standard plaque hybridization of a human mammary gland library, which suggests that the instantly claimed DNA sequence is a naturally occurring allele of the DNA sequence isolated by Conneely et al. Furthermore, there is no indication that the DNA sequence of the instant application results in any unexpected properties of the human lactoferrin protein encoded by SEQ ID#1 of applicant's invention. As stated in In re Mayne, 41 USPQ2d 1451, 1455 (Fed. Cir, 1997), applicant may make a showing of unexpected results "with evidence that the claimed invention exhibits some superior property or advantage that a person of ordinary skill in the relevant art would find surprising or unexpected."

Applicants have failed to make such a showing, therefore, SEQ ID #1 is anticipated by Conneely et al. as a naturally occurring allele of the DNA sequence isolated by Conneely et al. (SEQ ID # 1) which encodes for human lactoferrin. Thus, the rejection is maintained.

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No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen M. Hauda whose telephone number is (703) 305-6608.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasemine C. Chambers, may be reached at (703) 308-2035.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal

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Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is or (703) 305-3014 or (703) 308-4242.

Karen M. Hauda  
Patent Examiner  
September 2, 1997

*Jasemine C. Chambers*  
JASEMINE C. CHAMBERS, PH.D.  
SUPERVISORY PATENT EXAMINER  
GROUP 1800